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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92063591
Party	Defendant Stein Mart Holding Corp.
Correspondence Address	STEIN MART HOLDING CORP 1200 RIVERPLACE BOULEVARD JACKSONVILLE, FL 32207 UNITED STATES
Submission	Motion to Suspend for Civil Action
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Signature	/Elizabeth G. Borland/
Date	05/17/2016
Attachments	STEIN MART - Corrected Motion to Suspend - VINEYARD.pdf(14298 bytes) STEIN MART Exhibit A to Motion to Suspend 1.pdf(2941665 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 4,943,046
Registered: April 19, 2016
Mark: VINEYARD PLACE

VINEYARD VINES, LLC,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92063591
)	
STEIN MART HOLDING CORP.,)	
)	
Registrant.)	

**CORRECTED MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING
CIVIL ACTION PURSUANT TO TRADEMARK RULE 2.117(a)**

Registrant Stein Mart Holding Corp. (“Registrant”), by its attorneys, hereby moves for suspension of these proceedings pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a). Petitioner filed federal trademark infringement litigation against Registrant’s parent company Stein Mart, Inc., alleging that use of the VINEYARD PLACE mark infringes and/or dilutes Petitioner’s VINEYARD VINES mark and unfairly competes with Petitioner. This litigation is currently pending in the United States District Court for the Eastern District of New York, and bears Case No. 16-cv-38 (LDW) (AKT). A copy of Petitioner’s Complaint is attached as Exhibit A.

The pending civil action involves issues that are involved in this proceeding, namely, whether there is a likelihood of confusion, mistake or deception between the

marks involved in the proceeding and whether Registrant's VINEYARD PLACE mark dilutes the VINEYARD VINES mark.

Registrant therefore respectfully requests suspension of these proceedings pending disposition of the civil action pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a). *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971) (suspending cancellation proceeding in light of pending federal litigation because "the outcome of the civil action will have a direct bearing on the question of the rights of the parties herein and may in fact completely resolve all the issues").

This 17th day of May, 2016.

Respectfully submitted

SMITH, GAMBRELL & RUSSELL, LLP

s/ Elizabeth G. Borland

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Attorney for Registrant Stein Mart Holding Corp.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on May 17, 2016, a true and correct copy of the foregoing
CORRECTED MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL ACTION
PURSUANT TO TRADEMARK RULE 2.117(a) was served upon counsel for Petitioner by placing a
copy of same in the U.S. mail, postage prepaid, addressed as follows:

Larry C. Jones
Alston & Bird LLP
101 S. Tryon St., Suite 4000
Charlotte, NC 28280-4000

s/ Elizabeth G. Borland
Elizabeth G. Borland

EXHIBIT A

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Attorneys for Plaintiff Vineyard Vines, LLC

**IN THE UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK**

Vineyard Vines, LLC,)	
)	
Plaintiff,)	
)	Civil Action No. <u>16cv0038</u>
v.)	
)	Jury Trial Demanded
Stein Mart, Inc.,)	
)	
<u>Defendant.</u>)	

COMPLAINT

Plaintiff Vineyard Vines, LLC ("Vineyard Vines"), for its complaint against Defendant Stein Mart, Inc. ("Stein Mart"), alleges on personal knowledge as to its actions, and upon information and belief as to the actions of others, as follows:

NATURE OF THE ACTION

1. This action arises out of Defendant Stein Mart's knowing and intentional mimicry of Vineyard Vines' well known VINEYARD VINES clothing trademark. More particularly, this is an action for trademark infringement, trademark dilution, unfair competition, and several related federal, state and common law causes of action.

PARTIES

2. Vineyard Vines is a Connecticut limited liability company having its principal place of business located at 181 Harbor Drive, Stamford, Connecticut 06902.

3. Stein Mart, Inc. is a Florida corporation having a principal place of business located at 1200 Riverplace Boulevard, Jacksonville, Florida 32207.

JURISDICTION AND VENUE

4. This Court has subject matter jurisdiction over this lawsuit pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338 and 1367.

5. This Court has personal jurisdiction over Defendant Stein Mart because, *inter alia*, Stein Mart is located within this judicial district, has committed tortious acts within this judicial district, has transacted business within this judicial district (including sales of the infringing merchandise within this judicial district), and has otherwise made or established contacts within this judicial district sufficient to permit the exercise of personal jurisdiction by this Court over it.

6. Venue is proper within this Court pursuant to 28 U.S.C. §§ 1391(a) and (b) because Defendant Stein Mart is subject to personal jurisdiction within this judicial district and a substantial part of the events and injury giving rise to Vineyard Vines' claims is occurring within this judicial district.

PLAINTIFF AND ITS VINEYARD VINES TRADEMARK

7. In 1998, brothers Ian and Shep Murray set out to live the American dream and left their corporate jobs on Manhattan's Wall Street to create a line of whimsical men's neckties inspired by the colors and designs of Martha's Vineyard, a destination they loved to visit. The first 800 ties were delivered on July 3, 1998 and were sold out in the first

week. As the popularity of the neckties grew, the Vineyard Vines brand was expanded to a full line of casual sportswear for men, women and children, accessories, and products for the home, all drawing inspiration from the relaxed lifestyle of Martha's Vineyard.

8. For nearly twenty (20) years, and since long prior to the acts of Stein Mart complained of herein, Vineyard Vines has been engaged in manufacturing, distributing, offering for sale and selling a broad range of uniquely designed luxury brand men's, women's and children's clothing and accessories. As such, Vineyard Vines has become a leader in the clothing and accessories industry in this country and is well known for its colorful nautical designs on its products and in its advertising and promotional materials. From the beginning, Plaintiff has used the designation "VINEYARD VINES" as the brand identifying its clothing and accessory products.

9. The designation VINEYARD VINES has become an iconic trademark and is prominently used on a broad array of men's, women's and children's clothing and accessories, as well as other related goods.

10. Moreover, the VINEYARD VINES mark is consistently depicted on clothing labels and in other materials within a rectangular box and in a particular font with serifs, some examples of which labels are shown below:





11. Vineyard Vines now operates approximately seventy (70) VINEYARD VINES branded standalone retail and outlet locations throughout the United States and continues to expand its retail presence through additional prominent in-store and store-in-a-store facilities in many major retail stores, including Bloomingdale's, Belk, Nordstrom, Saks Fifth Avenue and Island Pursuits, as well as in boutique clothiers throughout the United States. Vineyard Vines also promotes and offers its products for sale on its web site, www.VineyardVines.com.

12. As a consequence of Vineyard Vines' longstanding and continuous use of its VINEYARD VINES mark, Vineyard Vines' business and merchandise have become closely associated with one another in the mind of the public so that the public in this country has come to recognize the business and merchandise of Vineyard Vines by the VINEYARD VINES mark, particularly when that designation is depicted in the font shown above. As such, Vineyard Vines enjoys substantial goodwill and a valuable reputation under the VINEYARD VINES clothing trademark.

13. Because the VINEYARD VINES designation has a distinctive quality and has acquired special and particular significance and very valuable goodwill as an identifier

of Vineyard Vines and its merchandise, Vineyard Vines has acquired proprietary rights in the VINEYARD VINES designation under the common law as a trademark and service mark for men's, women's and children's clothing and accessories, and for related goods and services. Those rights extend, without limitation, to the exclusive right to use the VINEYARD VINES designation nationwide on and in conjunction with such clothing goods and related merchandise and services.

14. Moreover, the VINEYARD VINES designation is the subject of several federal trademark and service mark registrations. Those registrations include, *inter alia*, U.S. Trademark Registration No. 2,318,245 which issued February 15, 2000 from an application filed August 6, 1998, and pertains to the use of the designation VINEYARD VINES in any font as a trademark for various clothing goods. That registration (a copy of which is attached hereto as Exhibit A) is valid, subsisting and incontestable. The VINEYARD VINES designation is also the subject of U.S. Service Mark Registration No. 4,781,997 which issued July 28, 2015 from an application filed December 22, 2014, and pertains to the use of the designation VINEYARD VINES in any font as a service mark for, *inter alia*, retail store services featuring clothing. A copy of that registration is attached hereto as Exhibit B.

STEIN MART'S UNLAWFUL ACTIVITIES

15. Defendant Stein Mart operates nearly 300 STEIN MART branded retail stores in which it sells clothing, accessories and other merchandise. Those stores are located in about 30 states, including New York, and at least one such store is located in this judicial district. Additionally, Stein Mart operates a website, www.steinmart.com, on

which it promotes and sells clothing and other merchandise to the public, including customers residing within this judicial district.

16. It came to Vineyard Vines' attention recently that Stein Mart is selling clothing under the designation VINEYARD PLACE. Examples of such merchandise (the "Infringing Goods") and Stein Mart's promotion of its VINEYARD PLACE merchandise are shown in Exhibit C hereto. That merchandise includes preppy styles of casual and leisure clothing, often in bright colors such as pink, lime green and light blue --- the same styles and colors as used prominently by Vineyard Vines.

17. As reflected in the images of Exhibit C and below, Stein Mart often presents the VINEYARD PLACE designation on clothing labels, in-store signage, and in other materials within a rectangular box and with the letters of the "VINEYARD" component depicted in a particular font with serifs:





18. The VINEYARD PLACE word mark resembles closely the VINEYARD VINES word mark in that it is comprised of two terms, the first and more prominent component of which is “VINEYARD,” and the second component of which is a word having five letters. Thus, there are unnecessarily imitative similarities of the appearances, sounds and commercial impressions of the VINEYARD PLACE and VINEYARD VINES word marks *per se*.

19. Further, in depicting the VINEYARD PLACE designation on sewn-in neck labels, in-store signage and elsewhere, Stein Mart has unnecessarily imitated the particular look and manner of presentation long used by Vineyard Vines in conjunction with its iconic VINEYARD VINES brand. As reflected below, Stein Mart’s mimicry is exacerbated by the presentation of the VINEYARD PLACE designation within a rectangular box, with the common “VINEYARD” component being significantly larger and more prominent than the “PLACE” component, and with all of the letters of the “VINEYARD” component in the same font, or a very highly similar font, as that in which the public has become accustomed to seeing the VINEYARD VINES designation.

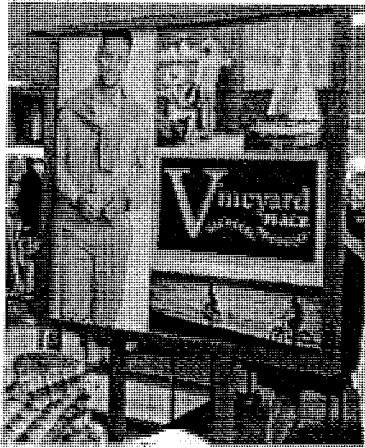


As such, the VINEYARD PLACE clothing is likely to be perceived by the public as an extension of the well-known VINEYARD VINES line of clothing.

20. Still further, and as reflected in the photographic images of Exhibit D and below, Stein Mart displays the VINEYARD PLACE clothing in its retail stores near or side-by-side authentic VINEYARD VINES clothing, thus enhancing the likelihood that customers will associate the two brands.



Moreover, Stein Mart's display headers and in-store signage directing customers to its VINEYARD PLACE clothing also incorporate prominent nautical images, just as Vineyard Vines has long incorporated nautical images prominently in its advertising and promotional materials.



In fact, the display headers' identification of the merchandise and its display shelves within each Stein Mart store as "VINEYARD PLACE" further connotes falsely that there is some form of commercial association between the VINEYARD VINES and VINEYARD PLACE clothing.

21. Because of such similarities, members of the public are likely to be initially interested in the Infringing Goods upon encountering them for sale by Stein Mart. Thus, such mimicry is likely to lead to either initial interest confusion or point-of-sale confusion as to the source, sponsorship or other commercial affiliation of the Infringing Goods with Vineyard Vines and its clothing.

22. Additionally, because of such similarities, members of the public, who encounter the Infringing Goods in the possession of Stein Marts' customers or other

persons, are likely to experience post-sale confusion as to the source, sponsorship or other commercial affiliation of the Infringing Goods with Vineyard Vines and its clothing.

23. The activities of Stein Mart complained of herein constitute willful infringement and dilution of Vineyard Vines's proprietary rights in the VINEYARD VINES mark and have continued in spite of Stein Mart's knowledge that the use of a colorable imitation of such proprietary mark was and remains in direct contravention of the exclusive proprietary rights of Vineyard Vines.

24. Stein Mart's unlawful activity results in irreparable harm and injury to Vineyard Vines in that, among other things, it: deprives Vineyard Vines of its absolute right to determine the manner in which its image is presented to the public through the promotion and sale of goods bearing reproductions or colorable imitations of its mark; deceives and confuses the public as to the origin and sponsorship of such goods either when members of the public initially encounter the Infringing Goods, and/or at the point-of-sale of the Infringing Products, and/or when the Infringing Goods are encountered in post-sale situations; wrongfully preys upon and cashes in on the reputation and commercial value of Vineyard Vines as well as its exclusive rights in the proprietary VINEYARD VINES mark; and irreparably harms and injures, or threatens to harm and injure, the reputation of Vineyard Vines for providing quality goods.

Count I

**DILUTION OF FAMOUS TRADEMARK
15 U.S.C. § 1125 (c) (§43 (c) of the Lanham Act)**

25. Vineyard Vines repeats and realleges the contents of Paragraphs 1-24 as thought fully set forth herein.

26. The VINEYARD VINES clothing mark is a famous trademark under 15 U.S.C. § 1125(c)(2)(A), in that it is widely recognized by the general consuming public of the United States as a designation of the source of Vineyard Vines' clothing and other merchandise. The VINEYARD VINES mark became famous long prior to Stein Mart's unlawful use of its colorable imitation thereof, as alleged herein.

27. Stein Mart's use of a colorable imitation of the VINEYARD VINES mark, in connection with the unauthorized sale in the United States of its Infringing Goods, is likely to dilute Vineyard Vines' famous VINEYARD VINES mark, in violation of § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), by lessening the capacity of the VINEYARD VINES mark to identify and distinguish Vineyard Vines exclusively as the source of products and services in the United States bearing or provided under the famous VINEYARD VINES mark and by harming the reputation and goodwill of the famous VINEYARD VINES mark.

28. Stein Mart's unauthorized use of a colorable imitation of the VINEYARD VINES mark in connection with the sale in the United States of Stein Mart's Infringing Goods is intended and has the effect of trading on Vineyard Vines' reputation and causing dilution of the famous VINEYARD VINES mark.

29. Stein Mart's trademark dilution as herein alleged has injured and will continue to injure Vineyard Vines in that Vineyard Vines has suffered and will continue to suffer damage to its reputation and customer goodwill as a direct and proximate result of Stein Mart's illegal conduct, unless such unlawful conduct is enjoined by this Court. In addition, Stein Mart has been unjustly enriched by reason of its acts of trademark dilution

in that Stein Mart has achieved sales and profits as a direct and proximate result of its illegal conduct.

30. Vineyard Vines is entitled to recover all damages sustained as a result of Stein Mart's actions, and all profits realized by Stein Mart through its unlawful use of a colorable imitation of the VINEYARD VINES mark and in connection with Stein Mart's offering for sale and sale of the Infringing Goods.

31. Stein Mart's actions have been willful and deliberate, entitling Vineyard Vines to recover treble damages and/or profits and an award of reasonable attorneys' fees against Stein Mart.

Count II

INFRINGEMENT OF FEDERALLY REGISTERED TRADEMARK 15 U.S.C. § 1114 (§ 32 of the Lanham Act)

32. Vineyard Vines repeats and realleges the contents of Paragraphs 1-31 as though fully set forth herein.

33. Stein Mart's use in commerce of a colorable imitation of the federally registered VINEYARD VINES mark in connection with the promotion, offering for sale, sale and distribution of clothing goods is likely to cause confusion, or to cause mistake or deceive customers, potential customers, and/or other members of the public.

34. Such acts constitute infringement of a federally registered trademark in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114.

35. The aforesaid acts of Stein Mart have injured Vineyard Vines in an amount to be determined at trial.

36. The aforesaid acts of Stein Mart have also caused irreparable harm to Vineyard Vines and, unless enjoined by this Court, will continue to cause irreparable

damage, loss and injury to Vineyard Vines, for which Vineyard Vines has no adequate remedy at law.

Count III

**FEDERAL TRADEMARK INFRINGEMENT
15 U.S.C. § 1125(a)(1)(A) (§ 43(a)(1)(A) of the Lanham Act)**

37. Vineyard Vines repeats and realleges the contents of Paragraphs 1-36 as though fully set forth herein.

38. Stein Mart's use in commerce of a colorable imitation of the VINEYARD VINES clothing trademark is likely to cause confusion, or to cause mistake or deceive consumers and other members of the public as to the affiliation, connection, or association of that imitative designation with Vineyard Vines or as to the origin, sponsorship or approval of Stein Mart's goods by Vineyard Vines.

39. Such acts constitute violations of § 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

40. The aforesaid acts of Stein Mart have injured Vineyard Vines in an amount to be determined at trial.

41. The aforesaid acts of Stein Mart have also caused and, unless enjoined by this Court, will continue to cause, irreparable damage, loss and injury to Vineyard Vines, for which Vineyard Vines has no adequate remedy at law.

Count IV

COMMON LAW UNFAIR COMPETITION

42. Vineyard Vines repeats and realleges the contents of Paragraphs 1-41 as though fully set forth herein.

43. Stein Mart has engaged in unfair competition with Vineyard Vines in violation of the common law of New York and other states, by advertising, promoting, offering and selling its products using a colorable imitation of the VINEYARD VINES clothing trademark, and by trading upon the goodwill established by Vineyard Vines and thereby misappropriating the benefits of substantial effort and money expended by Vineyard Vines in establishing its rights in its trademark and the goodwill and reputation of Vineyard Vines.

44. The aforesaid acts of Stein Mart have damaged Vineyard Vines in an amount to be determined at trial.

45. The aforesaid acts of Stein Mart have also caused Vineyard Vines irreparable injury and, unless enjoined by this Court, will continue to cause irreparable damage, loss and injury to Vineyard Vines, for which Vineyard Vines has no adequate remedy at law.

Count V

FALSE ADVERTISING In Violation of New York General Business Law § 350

46. Vineyard Vines repeats and realleges the contents of Paragraphs 1-45 as though fully set forth herein.

47. Stein Mart's unauthorized use of the imitative VINEYARD PLACE mark in commercial advertising or promotion, misrepresents characteristics of the goods on which that mark is used.

48. Stein Mart's acts described above constitute false advertising in violation of New York General Business Law § 350.

49. The aforesaid acts of Stein Mart have injured Vineyard Vines in an amount to be determined at trial.

50. The aforesaid acts of Stein Mart have also caused and, unless restrained and enjoined by this Court, will continue to cause, irreparable damage, loss and injury to Vineyard Vines, for which Vineyard Vines has no adequate remedy at law.

Count VI

UNFAIR COMPETITION

In Violation of New York General Business Law § 360-1

51. Vineyard Vines repeats and realleges the contents of Paragraphs 1-50 as though fully set forth herein.

52. The aforesaid acts of Stein Mart are likely to cause injury to Vineyard Vines' business reputation and result in Stein Mart unfairly competing with Vineyard Vines in violation of New York General Business Law § 360-1.

53. Stein Mart's acts described above constitute unfair competition in violation of New York General Business Law § 360-1.

54. The aforesaid acts of Stein Mart have injured Vineyard Vines in an amount to be determined at trial.

55. The aforesaid acts of Stein Mart have also caused and, unless restrained and enjoined by this Court, will continue to cause, irreparable damage, loss and injury to Vineyard Vines, for which Vineyard Vines has no adequate remedy at law.

Count VII

DILUTION

In Violation of New York General Business Law § 360-1

56. Vineyard Vines repeats and realleges the contents of Paragraphs 1-55 as though fully set forth herein.

57. The VINEYARD VINES trademark is widely recognized by consumers of clothing. The VINEYARD VINES clothing trademark is strong, highly distinctive and famous and achieved fame before Stein Mart commenced its unauthorized use of the imitative VINEYARD PLACE clothing designation.

58. The actions of Stein Mart are likely to cause confusion and dilute the distinctive quality of the VINEYARD VINES clothing trademark.

59. Such acts are in violation of New York General Business Law § 360-1.

60. The aforesaid acts of Stein Mart have injured Vineyard Vines in an amount to be determined at trial.

61. The aforesaid acts of Stein Mart have also caused great and irreparable injury to Vineyard Vines and, unless restrained by this Court, will continue to cause further irreparable damage, loss and injury to Vineyard Vines, for which Vineyard Vines has no adequate remedy at law.

JURY DEMAND

Vineyard Vines demands a trial by jury of all issues so triable.

PRAYER FOR RELIEF

WHEREFORE, Vineyard Vines respectfully requests the following relief:

A. Preliminary and permanent injunctions prohibiting Stein Mart, its officers, directors, agents, principals, divisions, sales representatives, servants, employees, resellers, associates, subsidiaries, affiliates, attorneys, successors and assigns and all persons acting by, through, under or in active concert or in participation with or controlled, either directly

or indirectly, by any of them, from using the VINEYARD PLACE designation, and from using any other colorable imitation of the VINEYARD VINES trademark in connection with the manufacturing, packaging, labeling, importation, exportation, advertising, promoting, marketing, offering, selling or distribution of clothing goods and any other merchandise in the United States;

B. Preliminary and permanent injunctions requiring Stein Mart to remove all use of the infringing and dilutive VINEYARD PLACE designation from its web site, store displays, clothing labels, sales aids, advertisements, and any other promotional material or medium;

C. An order requiring the surrender to Vineyard Vines of all goods and other materials in Stein Mart's possession, custody or control bearing the infringing and dilutive VINEYARD PLACE designation, for the destruction of such goods and materials by Vineyard Vines, and requiring further the filing and service of a certified report by Stein Mart, identifying and attesting to the surrender of those goods and other materials in such particular details as the Court shall deem appropriate;

D. An accounting for all profits derived by Stein Mart and its subsidiaries and other affiliates from such unlawful acts;

E. An award of such monetary remedies in an amount sufficient to compensate Vineyard Vines for losses it has sustained as a consequence of Stein Mart's unlawful acts, as well as the profits of Stein Mart and its subsidiaries and other affiliates attributable to such infringements and dilution;

F. An award of Vineyard Vines' damages, including treble damages, costs and attorneys' fees for Stein Mart's acts of trademark infringement and dilution, pursuant to 15 U.S.C. §§ 1051, *et seq.*, particularly including 15 U.S.C. §§ 1114 and 1125(a) and (c);

G. All such other and further relief as this Court may deem just and proper.

Dated: January 5, 2016

/s/ Wade G. Perrin

Wade G. Perrin

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Attorneys for Plaintiff,

Vineyard Vines, LLC

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON NEXT PAGE OF THIS FORM.)

I. (a) PLAINTIFFS

Vineyard Vines, LLC

(b) County of Residence of First Listed Plaintiff Fairfield County, CT
(EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorneys (Firm Name, Address, and Telephone Number)

Wade Perrin (Alston & Bird LLP; 90 Park Ave, New York, NY 10016;
212-210-9400; wade.perrin@alston.com)

DEFENDANTS

Stein Mart, Inc.

County of Residence of First Listed Defendant Duval County, FL
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF
THE TRACT OF LAND INVOLVED.

Attorneys (If Known)

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
☒ 3 Federal Question (U.S. Government Not a Party)
☐ 2 U.S. Government Defendant
☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- | | PTF | DEF | | PTF | DEF |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business in This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business in Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES	
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excludes Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury <input type="checkbox"/> 362 Personal Injury - Medical Malpractice	PERSONAL INJURY <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 367 Health Care/Pharmaceutical Personal Injury Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 690 Other LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Management Relations <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 751 Family and Medical Leave Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Employee Retirement Income Security Act IMMIGRATION <input type="checkbox"/> 462 Naturalization Application <input type="checkbox"/> 465 Other Immigration Actions	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark SOCIAL SECURITY <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609	<input type="checkbox"/> 375 False Claims Act <input type="checkbox"/> 376 Qui Tam (31 USC 3729(a)) <input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 896 Arbitration <input type="checkbox"/> 899 Administrative Procedure Act/Review or Appeal of Agency Decision <input type="checkbox"/> 950 Constitutionality of State Statutes
REAL PROPERTY <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 440 Other Civil Rights <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 448 Education	PRISONER PETITIONS Habeas Corpus: <input type="checkbox"/> 463 Alien Detainee <input type="checkbox"/> 510 Motions to Vacate Sentence <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty Other: <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition <input type="checkbox"/> 560 Civil Detainee - Conditions of Confinement			

V. ORIGIN (Place an "X" in One Box Only)

- ☒ 1 Original Proceeding
☐ 2 Removed from State Court
☐ 3 Remanded from Appellate Court
☐ 4 Reinstated or Reopened
☐ 5 Transferred from Another District (specify)
☐ 6 Multidistrict Litigation

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):
15 U.S.C. §§ 1114 and 1125 (a)(1)(A) and (c)

Brief description of cause:
Infringement of Federally Registered Trademark, Federal Trademark Infringement, Dilution of Famous Trademark

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER RULE 23, F.R.Cv.P.

DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ Yes ☐ No

VIII. RELATED CASE(S) IF ANY

(See instructions):

JUDGE

DOCKET NUMBER

DATE
01/05/2016

SIGNATURE OF ATTORNEY OF RECORD
/s/ Wade G. Perrin

FOR OFFICE USE ONLY

RECEIPT #

AMOUNT

APPLYING IFP

JUDGE

MAG. JUDGE

CERTIFICATION OF ARBITRATION ELIGIBILITY

Local Arbitration Rule 83.10 provides that with certain exceptions, actions seeking money damages only in an amount not in excess of \$150,000, exclusive of interest and costs, are eligible for compulsory arbitration. The amount of damages is presumed to be below the threshold amount unless a certification to the contrary is filed.

I, Wade Perrin, counsel for Vineyard Vines, LLC, do hereby certify that the above captioned civil action is ineligible for compulsory arbitration for the following reason(s):

- ☐ monetary damages sought are in excess of \$150,000, exclusive of interest and costs,
- ☒ the complaint seeks injunctive relief,
- ☐ the matter is otherwise ineligible for the following reason

DISCLOSURE STATEMENT - FEDERAL RULES CIVIL PROCEDURE 7.1

Identify any parent corporation and any publicly held corporation that owns 10% or more of its stocks:

None

RELATED CASE STATEMENT (Section VIII on the Front of this Form)

Please list all cases that are arguably related pursuant to Division of Business Rule 50.3.1 in Section VIII on the front of this form. Rule 50.3.1 (a) provides that "A civil case is "related" to another civil case for purposes of this guideline when, because of the similarity of facts and legal issues or because the cases arise from the same transactions or events, a substantial saving of judicial resources is likely to result from assigning both cases to the same judge and magistrate judge." Rule 50.3.1 (b) provides that "A civil case shall not be deemed "related" to another civil case merely because the civil case: (A) involves identical legal issues, or (B) involves the same parties." Rule 50.3.1 (c) further provides that "Presumptively, and subject to the power of a judge to determine otherwise pursuant to paragraph (d), civil cases shall not be deemed to be "related" unless both cases are still pending before the court."

NY-E DIVISION OF BUSINESS RULE 50.1(d)(2)

- 1.) Is the civil action being filed in the Eastern District removed from a New York State Court located in Nassau or Suffolk County? No
- 2.) If you answered "no" above:
- a) Did the events or omissions giving rise to the claim or claims, or a substantial part thereof, occur in Nassau or Suffolk County? Yes
- b) Did the events or omissions giving rise to the claim or claims, or a substantial part thereof, occur in the Eastern District? Yes

If your answer to question 2 (b) is "No," does the defendant (or a majority of the defendants, if there is more than one) reside in Nassau or Suffolk County, or, in an interpleader action, does the claimant (or a majority of the claimants, if there is more than one) reside in Nassau or Suffolk County? _____

(Note: A corporation shall be considered a resident of the County in which it has the most significant contacts).

BAR ADMISSION

I am currently admitted in the Eastern District of New York and currently a member in good standing of the bar of this court.

☒ Yes ☐ No

Are you currently the subject of any disciplinary action (s) in this or any other state or federal court?

☐ Yes (If yes, please explain) ☒ No

I certify the accuracy of all information provided above.

Signature: /s/ Wade G. Perrin

AO 440 (Rev. 06/12) Summons in a Civil Action

UNITED STATES DISTRICT COURT

for the
Eastern District of New York

Vineyard Vines, LLC,

Plaintiff(s)

v.

Stein Mart, Inc.,

Defendant(s)

Civil Action No. 16cv0038

SUMMONS IN A CIVIL ACTION

To: *(Defendant's name and address)*

Stein Mart, Inc.
1200 Riverplace Boulevard
Jacksonville, FL 32207

A lawsuit has been filed against you.

Within 21 days after service of this summons on you (not counting the day you received it) — or 60 days if you are the United States or a United States agency, or an officer or employee of the United States described in Fed. R. Civ. P. 12 (a)(2) or (3) — you must serve on the plaintiff an answer to the attached complaint or a motion under Rule 12 of the Federal Rules of Civil Procedure. The answer or motion must be served on the plaintiff or plaintiff's attorney, whose name and address are:

Wade G. Perrin
Alston & Bird LLP
90 Park Ave, 15th Fl
New York, NY 10016

If you fail to respond, judgment by default will be entered against you for the relief demanded in the complaint. You also must file your answer or motion with the court.

DOUGLAS C. PALMER
CLERK OF COURT

Date: _____

Signature of Clerk or Deputy Clerk

AO 440 (Rev. 06/12) Summons in a Civil Action (Page 2)

Civil Action No. 16cv0038

PROOF OF SERVICE

(This section should not be filed with the court unless required by Fed. R. Civ. P. 4 (l))

This summons for *(name of individual and title, if any)* _____
was received by me on *(date)* _____.

☐ I personally served the summons on the individual at *(place)* _____
on *(date)* _____; or

☐ I left the summons at the individual's residence or usual place of abode with *(name)* _____
_____, a person of suitable age and discretion who resides there,
on *(date)* _____, and mailed a copy to the individual's last known address; or

☐ I served the summons on *(name of individual)* _____, who is
designated by law to accept service of process on behalf of *(name of organization)* _____
on *(date)* _____; or

☐ I returned the summons unexecuted because _____; or

☐ Other *(specify)*:

My fees are \$ _____ for travel and \$ _____ for services, for a total of \$ 0.00 .

I declare under penalty of perjury that this information is true.

Date: _____

Server's signature

Printed name and title

Server's address

Additional information regarding attempted service, etc:

EXHIBIT A

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,318,245

United States Patent and Trademark Office

Registered Feb. 15, 2000

TRADEMARK
PRINCIPAL REGISTER

VINEYARD VINES

VINEYARD VINES LLC (CONNECTICUT LIMITED LIABILITY COMPANY)
48 PARSONAGE ROAD
GREENWICH, CT 06830

FOR: CLOTHING, NAMELY BATHING SUITS, JACKETS, PANTS, SCARVES, SHORTS, SKIRTS, SHIRTS, SOCKS, SWEATERS, SWEAT-SHIRTS, SWEATPANTS, TIES, UNDERWEAR,

HATS, CAPS AND VISORS, IN CLASS 25 (U.S. CLS. 22 AND 39);

FIRST USE 6-20-1998; IN COMMERCE 7-3-1998.

SER. NO. 75-532,085, FILED 8-6-1998.

KIM SAITO, EXAMINING ATTORNEY

EXHIBIT B

United States of America
United States Patent and Trademark Office

Vineyard Vines

Reg. No. 4,781,997

Registered July 28, 2015

Int. Cl.: 35

SERVICE MARK

PRINCIPAL REGISTER

VINEYARD VINES, LLC (CONNECTICUT LIMITED LIABILITY COMPANY)
37 BROWN HOUSE ROAD
STAMFORD, CT 06902

FOR: RETAIL STORE AND ONLINE RETAIL STORE SERVICES FEATURING CLOTHING,
TOWELS, JEWELRY, BEVERAGWARE, PHONE ACCESSORIES AND FASHION ACCESSOR-
IES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 6-20-1998; IN COMMERCE 7-3-1998.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PAR-
TICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,991,523, 4,592,543 AND OTHERS.

SER. NO. 86-488,356, FILED 12-23-2014.

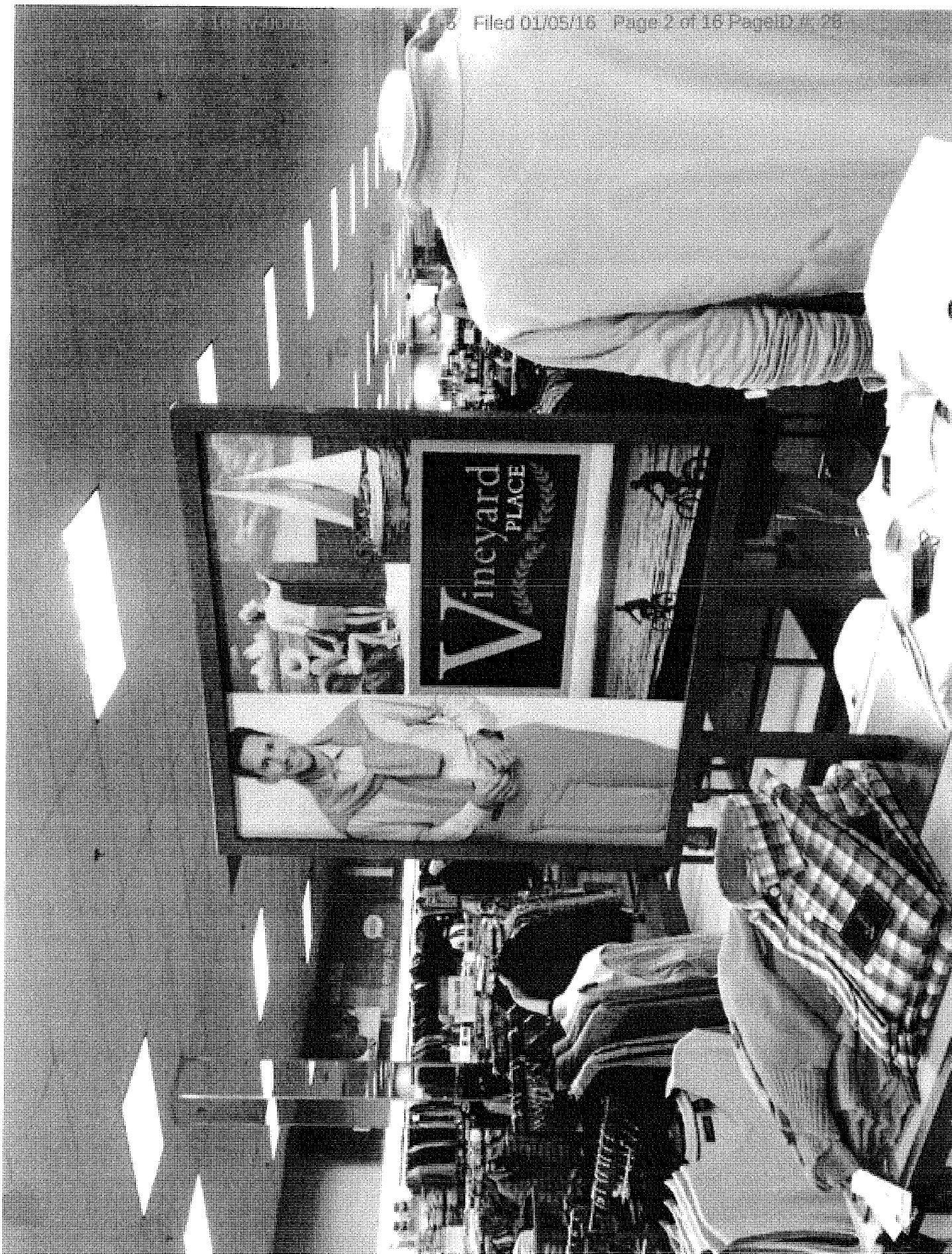
GEORGE LORENZO, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office

EXHIBIT C









Letter M

BLUE

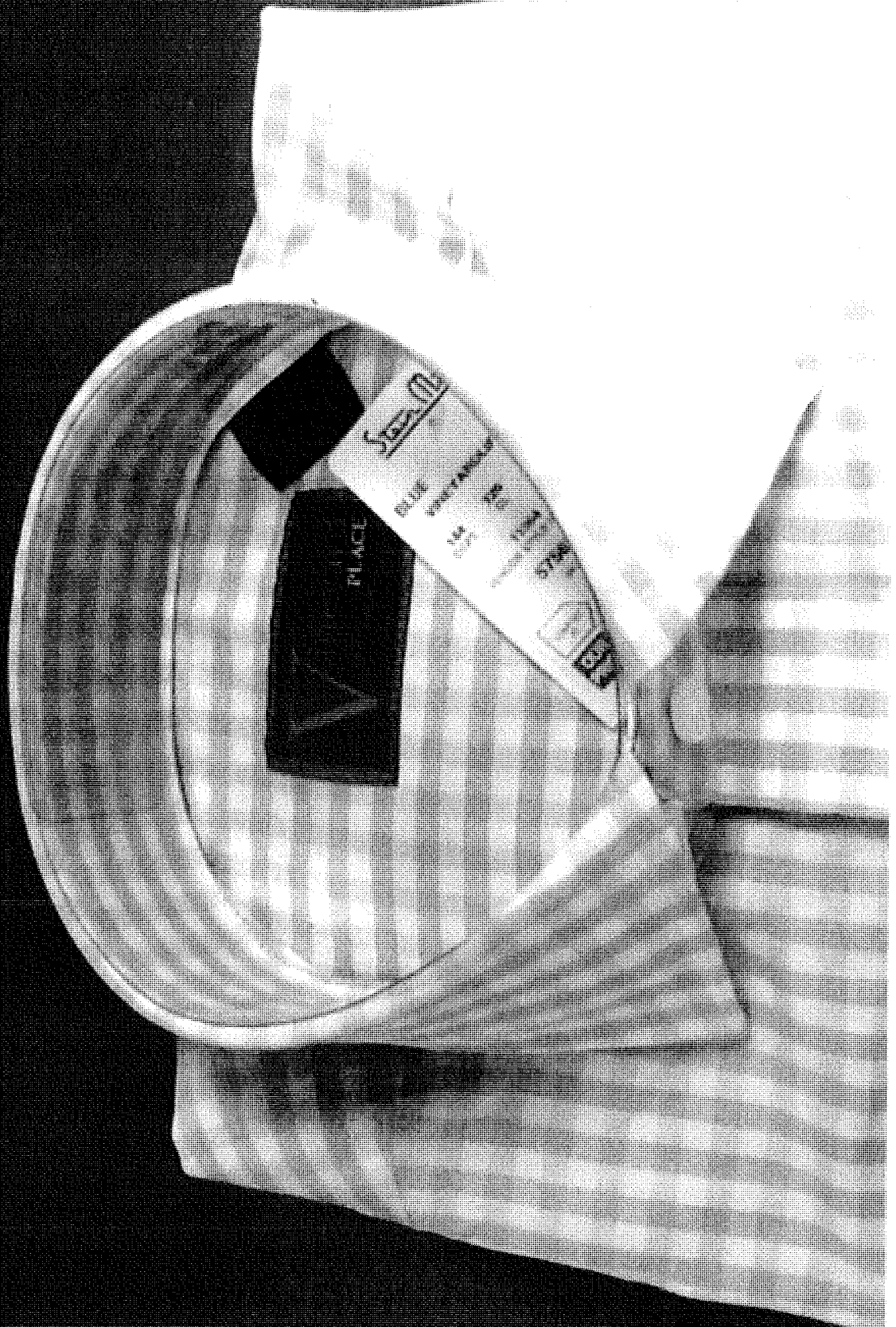
VOLEYARD UNIT, SMALL

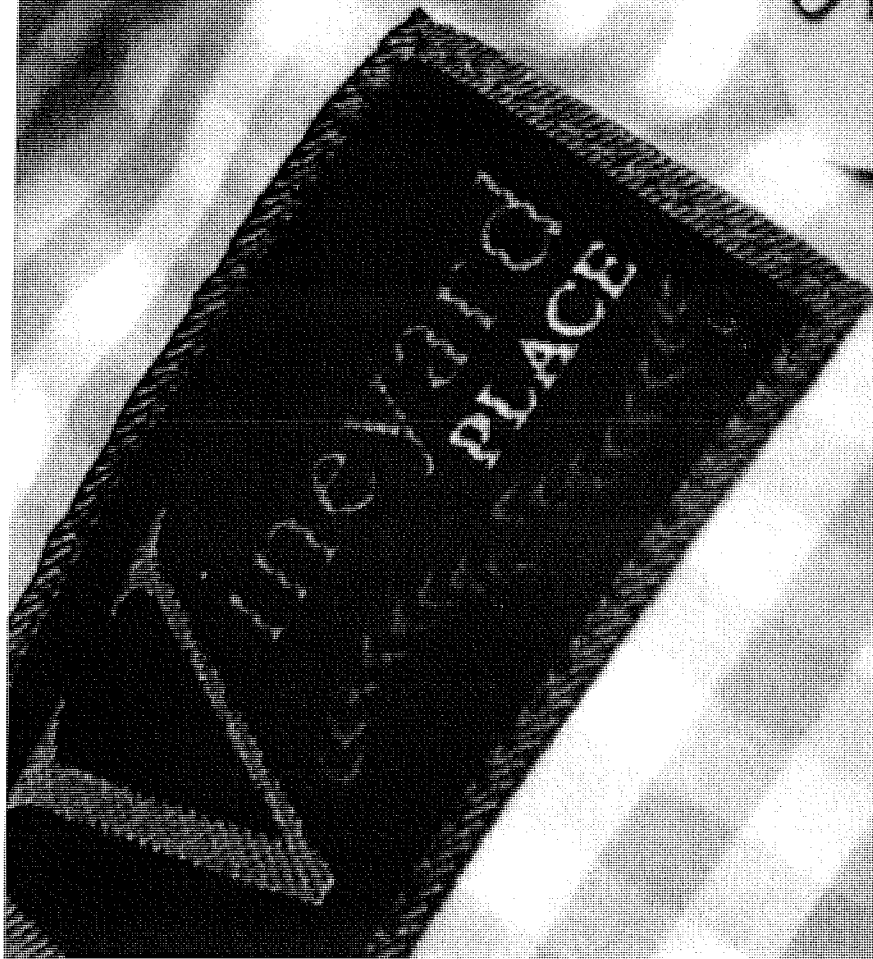
144











Stain Mart

SMALL

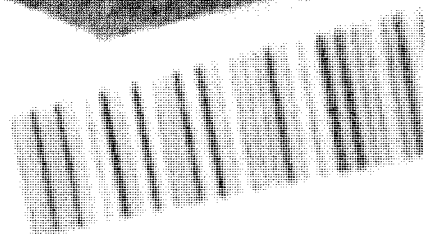
BLUE
VINEYARD LIFE 11

802
SLA

120
CL

144
DEPT

110004











FREE SHIPPING on purchases over \$75
& free returns in-store | See Details »



Search keyword or item

1. Home
2. Search Results: Vineyard

Refine by

SIZE

S
M
L
XL
XXL
ONE SIZE

We found 14 items that matched your search term "Vineyard"

Sort By:

Items Per Page:

View All

Pages:

1

COLOR



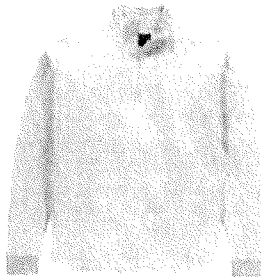
PRICE RANGE

- ☐ less than \$25
☐ \$25 - \$50
☐ \$50 - \$100

PRICE TYPE

- ☐ New Arrivals

Quick View



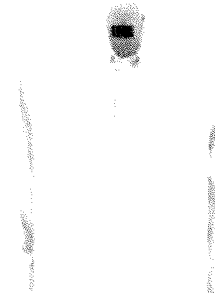
Blue
Green
Pink
White
Yellow
Vineyard Place
Striped Cuff Quarter Zip
Sweatshirt
Compare at \$79.50
\$39.99

Quick View



Blue
Green
Red
Vineyard Place
Stretch Cotton Polo Shirt
Compare at \$69.50
\$24.99

Quick View



Blue
Vineyard Place
Solid Button Down Shirt
Compare at \$69.50
\$29.99

Quick View



Pink
Vineyard Place
Solid Button Down Shirt
Compare at \$69.50
\$29.99

[Quick View](#)



Blue
Vineyard Place
Striped Button Down Collared
Shirt
Compare at \$69.50
\$29.99

[Quick View](#)



Blue
Vineyard Place
Gingham Button Front Shirt
Compare at \$69.50
\$29.99

[Quick View](#)



Green
Vineyard Place
Micro-Checked Button Down
Shirt
Compare at \$69.50
\$29.99

[Quick View](#)



Blue
Vineyard Place
Dotted Button Front Shirt
Compare at \$69.50
\$29.99

[Quick View](#)



White
Vineyard Place
Solid Button Down Shirt
Compare at \$69.50
\$29.99

[Quick View](#)



Green
Vineyard Place
Micro-Checked Button Front
Shirt
Compare at \$69.50
\$29.99

[Quick View](#)



Pink
Vineyard Place
Banker Stripe Button Down
Woven Shirt
Compare at \$69.50
\$29.99

[Quick View](#)



Green
Vineyard Place
Micro-Checked Button Front
Shirt
Compare at \$69.50
\$29.99

[Quick View](#)



Blue
Tommy Hilfiger
Woven Vineyard Boxer
Compare at \$20.00
\$9.99

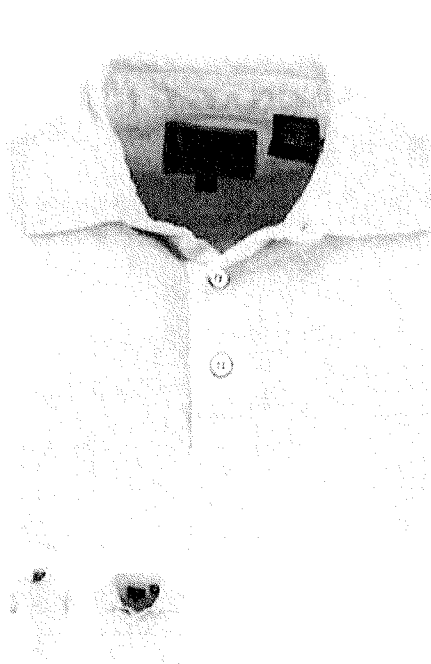
EXTRA 30% OFF clearance
online & in-store use code: SHOPCLER

20% OFF one sale item
online & in-store use code: SHOPSALE

FREE SHIPPING on purchases over \$75
 & free returns in-store | See Details »



Search keyword or item



Vineyard Place
Stretch Cotton Polo Shirt
 Stein Mart Style #: 57710741
 Compare at \$69.50
\$24.99

Men's Size Charts

The Following information is only to be used as a guideline as Sizing may vary by Product and/or Brand.
[Click here for all our size charts.](#)

MEN'S PANTS													
INSEAM WAIST SIZE													
	28"	29"	30"	31"	32"	33"	34"	35"	36"	38"	40"	42"	44"
28"													
29"													
30"			X		X	X	X		X	X	X	X	X
32"			X		X	X	X		X	X	X	X	X
34"					X	X	X		X	X	X		

MEN'S APPAREL					
SIZE	S	M	L	XL	XXL
NECK	14½"	15"-15½"	16"-16½"	17"-17½"	18"-18½"
CHEST	34"-36"	38"-40"	42"-44"	46"-48"	50"-52"
SLEEVE	32"	34"	35" (L)	35½"	36"
	33" (R)				
WAIST	28"-30"	31"-34"	35"-38"	40"-42"	44"-46"
HIP	34"-36"	38"-40"	42"-44"	46"-48"	48"-50"

MEN'S ACCESSORIES				
SIZE	S	M	L	XL
BELTS	30"-32"	33"-35"	36"-39"	40"-43"
SOCKS	7"-12"	10"-13"	13"-16"	
HATS	22½"	22½"	23½"	23½"
GLOVES	7"-8"	8"-9"	9"-10"	

MEN'S SHOES		
US	UK	EUROPE
7	5½	40½
7½	6	41
8	6½	41½
8½	7	42
9	7½	42½
9½	8	43
10	8½	43½
10½	9	44
11	9½	44½
11½	10	45
12	10½	45½
13	11½	46½

MEN'S SLIPPERS			
	U.S. Sizes	European Sizes	U.K. Sizes
M	8-9	41-42	7.5-8.5
L	9.5-10.5	42-44	9-10
XL	11-12	44-45	10.5-11.5
XXL	13-14	46-47	12.5-13.5

[Click here to see all size charts](#)

PLEASE SELECT A COLOR:

- ☐ Blue
- ☒ Green
- ☐ Red

May We Suggest

[Quick View](#)



Sharper Image
 Wireless Headphones
 Compare at \$49.99
\$19.98

[Quick View](#)



Alan Flusser
 Exclusively Ours -
 Cashmere V-Neck
 Sweater
 Compare at \$238.00
\$69.98
\$89.98

[Quick View](#)



Weatherproof
 32 Degrees Heat
 Retention Crew Neck
 Shirt
 Compare at \$28.00
\$12.98

[Quick View](#)



Alan Flusser
 Exclusively Ours - Cotton
 Cashmere Textured
 Sweater
 Compare at \$85.00
\$39.99

EXHIBIT D



